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10/724,351

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8066

7590

12/11/2007

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EXAMINER

PATEL, JAY P

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,351

Applicant(s)

LUND, ARNOLD M.

Examiner

Jay P. Patel

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the remarks received on 10/01/2007.
2. Claims 1-5, 7 and 21-30 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-4, 7, 21, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (US Patent 5916302).
5. In regards to claim 1, Dunn et al. (US Patent 5916302) disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 1, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called party and the calling party). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and carrying voice on the telephony network and data on the virtual data network).

In regards to claim 3, step 43 in figure 6a shows that the data signals represent displayable images, visual cues to be displayed and service request changes.

In regards to claim 4, at step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice.

In regards to claim 7, at steps 40 and 41, voice signals and data images flow between all conferees.

6. In regards to claim 21, Dunn et al. (US Patent 5916302) disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 21, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called party and the calling party). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and a parallel synchronized operation of the voice and data channel between the calling party and the called party).

In regards to claim 23, step 43 in figure 6a shows that the data signals represent displayable images, visual cues to be displayed and service request changes.

In regards to claim 25, at steps 40 and 41, voice signals and data images flow between all conferees.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5, 22, 26, 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) in view of Berkley et al. (US Patent 6546005 B1).

9. In regards to claims 2, 5 and 22 Dunn teaches all the limitations of parent claims 1 and 21. Dunn however, fails to teach the determining the configurations of the parties involved, establishing the virtual data channel if the configurations are compatible and accessing a database to determine the broadband access capabilities.

Berkley however, teaches the above-mentioned limitations in the active user registry disclosed in figure 2 which is queried anytime a user need to communicate through a packet or a voice network. The database is inclusive of multimedia capabilities 280, LAN and modem IP addresses 260 and URL addresses 270.

Furthermore, the calling party is contacted first with a preferred method designated by the party (see column 9, lines 37-46).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

10. In regards to claim 26, Dunn et al. disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 26, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called party and the calling party over a subscriber loop). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and carrying voice on the telephony network and data on the virtual data network over the subscriber loop).

In further regards to claim 26, Dunn fails to teach, determining a data address for the calling party on a data network and a data address for a called party on the data network. Berkley et al. however, teach the above-mentioned limitation where a database is queried in the user registry to ascertain the identification information (see figure 2, element 260).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

In regards to claim 29, Dunn teaches in figure 6a, at steps 40 and 41, voice signals and data images flow between all conferees.

In regards to claims 27 and 30, Dunn in combination with Berkley teaches all the limitations of parent claims 26 and 29. However, Dunn fails to teach ascertaining a data address that is an IP address. Berkley teaches the above-mentioned limitation where a database is queried in the user registry to ascertain the identification information (see figure 2, element 260).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) and Berkley et al. (US Patent 6546005 B1) as applied to claim 21 above, and further in view of Fukuoka et al. (US Patent 5914940).

12. In regards to claim 24, Dunn in combination with Berkley teaches all the limitations of parent claim 21 as stated above.

Neither Dunn nor Berkley however teaches, sending video signals over the virtual data network. Fukuoka however, teaches the above-mentioned limitation in figure 5 step S8 where a composite video packet is sent over a packet zed network.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to allow the transmission of a video packet as taught by Fukuoka in the data network taught by Dunn. The motivation to do so would be allow a network user to send video signal in order to enhance the conferencing between all the parties involved.

13. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) and Berkley et al. (US Patent 6546005 B1) as applied to claims 26 and 27 above and further in view of DeSimone et al. (US Patent 6138144).

In regards to claim 28, Dunn in combination with Berkley teaches all the limitations of parent claims 26 and 27. Neither Dunn nor Berkley teaches the virtual data channel using an ATM protocol.

DeSimone however, teaches the above-mentioned limitation in figure 1 where a user 101-1 establishes a connection with multicast server 130 using the ATM protocol (see column 7, lines 1-2).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to use of the ATM protocol as taught by DiSimone to set up the virtual data channel as taught by Dunn. The motivation to do so would be to allow the option of assigning the variable bit rate services that ATM allows.

Response to Arguments

14. Applicant's arguments filed 10/01/2007 have been fully considered but they are not persuasive.

15. In regards to claims 1 and 21, the applicant argues the Dunn fails to teach automatically establishing a separate data channel. However, the examiner respectfully disagrees. The broadest possible interpretation of the relevant claim language fails to elaborate on the term "automatic" (note: the examiner is not conceding that an elaboration of the term "automatic" would make the claim allowable). Furthermore, the applicant does concede on page 8 that Dunn indeed discloses that the participants

establish their own voice and data channels. Therefore, an establishment of a data channel anticipates an establishment of a separate parallel data channel. In further regards, reference 41 in figure 6a states that "image data flows from originating conferee to conference server to other conferees; remaining separate from voice throughout their handling to and from the server."

In regards to claim 26, the applicant states on page 21 that Berkley does not disclose establishing a voice channel and automatically establishing a virtual data channel in response to receiving a telephone call. However, the examiner hasn't relied on Berkley with regards to claim 26, to teach this limitation. The examiner has relied on Berkley to teach, determining a data address for the calling party on a data network and a data address for a called party on the data network.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay P. Patel whose telephone number is (571) 272-3086. The examiner can normally be reached on M-F 9:00 am - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPP 12/7/07
Jay P. Patel
Examiner
Art Unit 2619

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SUPERVISORY PATENT EXAMINER

Edan Orgad 12/16/07